



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): **Bianchi et al.**  
Application No.: **09/782,594**  
Filed: **2/12/2001**  
Title: **ASSEMBLED IMPLANT**  
Attorney Docket No.: **RTI-112R**

#15  
Group Art Unit: **1615**

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**RESPONSE TO DECISION DISMISSING PETITION UNDER 37 C.F.R. §1.78(a)(3)**

Commissioner for Patents  
Washington, D.C. 20231

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Sir:

This is in response to the attached Decision on the Response to Decision dismissing Petition under 37 C.F.R. §1.78(a)(3), dated May 10, 2002. Applicants provide the following items and remarks:

- (X) Third Preliminary Amendment. It is the Applicants assertion that this Preliminary Amendment addresses the Officer's concerns with respect to the language contained in the "Cross-Reference to Related Applications" section of the application. If the Officer believes that the language still does not comply with the rules, Applicants request that the undersigned be notified so that a supplementary amendment may be provided.
- (X) Executed Declaration and Power of Attorney. The attached Decision states that previously filed Declaration is defective. On July 18, 2002, the undersigned discussed the requirements for the Declaration with Officer Woods. In accord with the understanding reached between the undersigned and Officer Woods, Applicants provide herewith a Supplemental Declaration signed by P.J. Gorham and Michael Esch, which correctly states their citizenship. This supplemental oath is submitted to address the omission in citizenship on the previously submitted Declaration. Applicants respectfully request that the Officer call the undersigned if he believes that the Supplemental Declaration does not meet requirements under the patent rules.
- (X) The filing receipt for 09/701,933. The attached Decision states that Application No. 09/701,933 does not have a filing date, and therefore no application can claim priority to it. The enclosed filing receipt demonstrates that the '933 application does indeed have a filing date. Furthermore, the enclosed filing receipt shows that Kevin Carter is named as an inventor, who is also named as an inventor in the present 09/782,594 application. Applicants request that the Officer call the undersigned should he be of the opinion that any issues remain with respect to claiming priority to the '933 application.
- (X) Petition and Fee for a Two-Month Extension of Time.
- (X) Payment is by Credit Card. Form PTO-2038 is attached.

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In view of the foregoing items, Applicants request reconsideration of the Dismissed Petition under 37 C.F.R. §1.78(a)(3).

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope with sufficient postage addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Date of Deposit: 08/23/02

Typed Name: Timothy H. Van Dyke

Signature: 

Respectfully submitted,

By 

Timothy H. Van Dyke, Reg. No. 43,218

Date: 08/23/02

Customer No: 29847

Van Dyke & Associates, P.A.

772 Lake Ellenor Drive, Suite 252

Orlando, FL 32803

Phone: 407-228-0328; Fax: 407-228-0329



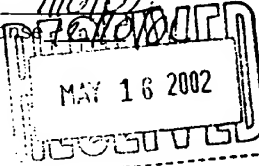
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Date received *9/12/02*  
Docketed *9/12/02* By *MR*  
Timely response due *7/10/02*  
Last date to file response *7/10/02*

**TIMOTHY H. VAN DYKE  
BENCEN & VAN DYKE, P.A.  
1630 HILLCREST STREET  
ORLANDO, FLORIDA 32803**



Paper No. 14

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MAY 10 2002

In re Application of  
John R. Bianchi et al.  
Application No. 09/782,594  
Filed: February 12, 2001  
Attorney Docket No. RTI-112R

:  
:  
: DECISION GRANTING DECISION  
: UNDER 37 CFR 1.78(a)(3)  
:

OFFICE OF PETITIONS

This is a decision on the Response to Decision Dismissing Petition under 37 CFR 1.78(a)(3), filed January 7, 2002, to accept an unintentionally delayed claim under 35 USC 120 for the benefit of two prior filed copending nonprovisional applications, numbers 08/920,630, filed August 27, 1997, and 09/701,933, filed August 25, 1998. A petition for a five (5) month extension of time is also requested and is hereby granted.

The petition is **dismissed**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 CFR 1.78." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

**Background**

A petition to accept an unintentionally delayed claim for the benefit of two prior filed copending applications, filed July 25, 2001, was dismissed by this Office in a Decision mailed on September 5, 2001, because a reference to the subject two prior nonprovisional applications had not been included in an ADS as provided by 37 CFR 1.76 or in the first sentence of the specification following the title as required by 37 CFR 1.78(a)(2). Also, the statement in the first line of the specification which stated that "[t]his application is a continuation-in-part of pending provisional application serial number 60/181,622" was improper.

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It was noted in the Decision that, in this regard, an application claiming the benefits of a provisional application under 35 USC 119(e) should not be called a continuation, a division, or a

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continuation-in-part. Note MPEP 201.07, 201.08 and 306.01. It was also noted that it appeared that incorrect application numbers were included in the claim for priority under 35 USC 120 in the first sentence of the specification following the title; namely, "09/370,194" should have read -- 09/390,194<sup>1</sup> -- and "09/191,132" should have read -- 09/191,232 -- . It was further noted that the incorrect application numbers also appeared in the executed declaration received May 25, 2001.

A further review of the file record disclosed that the reply to the Notice to File Missing Parts (Notice) was defective in that the executed Declaration and Power of Attorney lacked the citizenship of inventors P. J. Gorham and Michael Esch as required by 35 USC 115. A declaration in compliance with 35 USC 115 and 37 CFR 1.63(a)(3) was required.

Finally, it was noted that the preliminary amendment under 37 CFR 1.115 accompanying the instant petition was unsigned. A signed amendment was required if petitioner desired to have the preliminary amendment considered.

#### Applicable Law

A petition under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2), and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

- (1) the surcharge as set forth in 37 CFR 1.17(t);
- (2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) and the date the claim was filed as unintentional; and
- (3) the reference to the prior filed nonprovisional application, supplied in an application data sheet, or as an amendment in the first sentence following the title. See 35 USC 120 and 37 CFR 1.78(a)(2). The Commissioner may require additional information where there is a question whether the delay was unintentional.

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<sup>1</sup>It is noted that the application serial number should have read 09/390,174. Petitioner has made this correction on the Second Preliminary Amendment submitted with the instant petition.

The Instant Petition

This petition lacks item (3).

The first line of the specification has been amended to state:

This application is a continuation-in-part of pending application serial numbers 09/191,232, filed on November 13, 1998, pending; and of 09/378,527, filed on August 20, 1999, pending; and of 09/390,174, filed on September 7, 1999, pending, and of 29/123,227, filed on May 12, 2000, pending. This application is also related to provisional application serial number 60/181,622, filed February 10, 2000, and to non-provisional application number 08/920,630, filed August 27, 1997; and of non-provisional application number 09/701,933, filed August 25, 1998. The priority of all of the foregoing is claimed herein under 35 U.S.C. §119 and §120. The subject matter and disclosure of all the foregoing is hereby incorporated by reference as if fully set forth herein.

The application currently claims the benefit of application numbers 60/181,622, filed February 10, 2000; 09/191,232, filed on November 13, 1998; 09/378,527, filed on August 20, 1999, and of 09/390,174, filed on September 7, 1999.

The applications for which the benefit is sought are application numbers 29/123,227, filed May 12, 2000; 08/920,630, filed August 27, 1997, and 09/701,933, putatively filed on August 25, 1998. However, Petitioner has not indicated the relationship of the applications for which the benefit is sought and the instant application as required by 37 CFR 1.78(a)(2). That section provides that

[e]xcept for a continued prosecution application filed under 37 CFR 1.53(d), any nonprovisional application claiming the benefit of one or more prior filed copending nonprovisional applications or international applications designating the United States of America must contain a reference to each such prior application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and *indicating the relationship of the applications.* (Emphasis supplied)

Here, Petitioner has not indicated the relationship of the

applications, but simply provided that "[t]his application is also related" to the applications for which the benefit is sought. The Manual for Patent Examining Procedure ("MPEP") §201.11, provides that

"[w]hen a nonprovisional application (other than a CPA) is entitled under 35 U.S.C. 120 to an earlier U.S. effective filing date, a statement such as 'This is a division (continuation, continuation-in-part) of Application No. ---, filed ---' should appear as the first sentence of the description or in an application data sheet, except in the case of a design applications . . . ."

Petitioner must amend the specification to state the relationship of the instant application to the application(s) for which the benefit is sought.

Further, the proposed amendment lumps together, and thus confuses, claims for the benefit under both 35 USC 119(e) and 35 USC 120. As noted above, it is inappropriate for applicant to denote a given application as continuation of a continuation-in-part of a provisional application. The proposed amendment is also improper for another reason: where it attempts to incorporate by reference, after the filing date, one or more previous applications. The proposed amendment under 35 USC 120 cannot be accepted as drafted since it improperly incorporates by reference the prior applications. Petitioner's attention is directed to *Dart Industries v. Banner*, 636 F. 2d 684, 207 USPQ273 (C.A.D.C. 1980), where the court drew a distinction between the permissible 35 USC 120 statement, and the impermissible introduction of new matter by way of incorporation by reference in a 35 USC 120 statement. The court specifically stated:

Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. *In re deSeversky*, *supra* at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore "limit" the absolute and express prohibition against new matter contained in section 251 [or 132]. *Id.* At 688, 207 USPQ at 276.

Moreover, inspection of the declaration filed January 7, 2002, reveals the same execution dates as the declaration filed May 25, 2001, and, as such, the later filed declaration appears to be a

photocopy of the earlier declaration. However, since the later-filed declaration has been amended to now include the citizenship of the inventors, and such amendment occurred subsequent to signature, it cannot be accepted. See MPEP 206.01. A new declaration is required.

In addition, investigation reveals that application number 09/701,933 lists as a sole inventor, Jamie M. Grooms. The present application, which claims priority to application number 09/701,933, does not list Jamie M. Grooms as an inventor. Thus application number 09/701,933 does not appear eligible for a priority claim within the meaning of 35 USC 120 and 37 CFR 1.78. *h*

Finally, application number 09/701,933 has yet to receive a filing date. Petitioner can not claim the benefit of 09/701,933 as there is no filing date from which a benefit may be claimed.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents  
Box DAC  
Washington, D.C. 20231

By FAX: (703) 308-6916  
Attn: Office of Petitions

By HAND: Crystal Plaza Four, Suite 3C23  
2201 South Clark Place  
Arlington, Virginia 22202

Telephone inquiries concerning this matter should be directed to petitions attorney Derek L. Woods at (703) 305-0014.

*B. G. Planagan*  
Beverly M. Planagan  
Supervisory Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

*BH*  
Conferee: Brian Hearn

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COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
WWW.USPTO.GOV

APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO.	DRAWINGS	TOT CLAIMS	IND CLAIMS
09/701,933	08/20/2001	3738	2598	TB-1041A- US	22	65	15

Timothy H Van Dyke  
Bencen & Van Dyke  
1630 Hillcrest Street  
Orlando, FL 32803

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CONFIRMATION NO. 1292

FILING RECEIPT



\*OC000000007612284\*

Date Mailed: 03/15/2002

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

**Applicant(s)**

Tom Sander, Alachua, FL;  
Kevin C. Carter, Alachua, FL;  
Loic Josse, Palais, FRANCE;  
Lawrence M. Boyd, Memphis, TN;

**Domestic Priority data as claimed by applicant**

THIS APPLICATION IS A 371 OF PCT/US98/17769 08/27/1998  
AND A CIP OF 08/920,630 08/27/1997 ABN

**Foreign Applications**

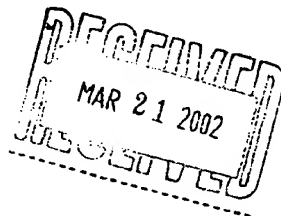
**Projected Publication Date:** Not Applicable, filed prior to November 29, 2000

**Non-Publication Request:** No

**Early Publication Request:** No

**Title**

Cortical bone cervical smith-robinson fusion implant

**Preliminary Class**

CTS  
Date received 3/21/02  
Docketed 3/21/02 By WMR  
Timely response due \_\_\_\_\_  
Last date to file response \_\_\_\_\_



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**Title 37, Code of Federal Regulations, 5.11 & 5.15**

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